

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant(s): Aakash Bordia Examiner: Sing, Simon P

Serial No. : 10/726,047 Group Art No.: 2614

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Title : A METHOD AND SYSTEM FOR EXCLUDING RECIPIENTS
 IN AN ELECTRONIC COMMUNICATION SYSTEM

Mail Stop Appeal Brief-Patents
Commissioner for Patents
Alexandria, VA 22313-1450

APPELLANT'S BRIEF PURSUANT TO 37 C.F.R. § 1.192

This Appellant's brief is hereby submitted in accordance with a Notice of Appeal
filed on March 28, 2007.

I. Real Party in Interest

The real party in interest is INTERNATIONAL BUSINESS MACHINES CORPORATION.

II. Related Appeals and Interferences

Appellant is not aware of any appeals or interferences that are related to the present case.

III. Status of the Claims

This is an appeal brief from a decision by the Primary Examiner dated January 11, 2007, finally rejecting all the claims currently pending in the present application. No claims have been allowed. The currently pending claims are 1-20.

The rejections of claims 1-20 are the subject of this appeal.

A notice of Appeal was filed on March 28, 2007.

IV. Status of Amendments

Claims 1, 7, 13, 19, and 20 were amended March 28, 2007, in response to the Final Office Action of January 11, 2007, in order to put the application in better condition for appeal by addressing claim rejections under 35 U.S.C. 112, second paragraph. Those amendments have been entered by the Examiner, as indicated in the Advisory Action of April 20, 2007, and are respectfully believed to overcome the Examiner's previous rejections under 35 U.S.C. 112, second

paragraph, since the Advisory Action indicates that claims remain rejected only because of the prior art rejection based on the Ellendman reference, addressed below.

V. Summary of Claimed Subject Matter

The subject matter of independent claims 1, 7, 13 and 19 is directed to a method and system of processing a message for transmission, including receiving an include set of recipient entities through a destination user input field within a graphical user interface window, and receiving an exclude set of recipient entities through an exclude user input field within the graphical user interface window, as disclosed beginning at line 14 on page 8 of the Specification through line 13 on page 9. The independent claims are further directed to assigning, by a source server system, a difference between the include set of recipient entities and the exclude set of recipient entities to the include set of recipient entities, as disclosed in lines 5-13 on page 10, and lines 7-9 on page 11 of the Specification. Also set forth in the independent claims is determining, by a destination server system, a result of a difference operation between the include set of recipient entities and the exclude set of recipient entities, and sending, by the destination server system, the message to destinations indicated by those recipient entities within the resulting difference, as disclosed in lines 2-6 on page 12 of the Specification.

Dependent claims 2, 8 and 14 are directed to displaying a carbon copy user input field in order to input the include set of recipient entities, as disclosed in lines 14-19 on page 8 of the Specification.

Dependent claims 3, 9 and 15 are directed to displaying a blind carbon copy user input field to input the include set of recipient entities, as also disclosed in lines 14-19 on page 8 of the Specification.

Dependent claims 4, 10 and 16 are directed to the include set of recipient entities including a list identifier, and resolving that list identifier in the source server system, where the resolving includes determining at least one individual address associated with the list identifier, as shown in step 52 of Fig. 4, and disclosed at line 22 on page 10 through line 1 on page 11 of the Specification.

Dependent claims 5, 11 and 17 are directed to the exclude set of recipient entities including a list identifier, and resolving that list identifier at the destination server system, where the resolving includes determining at least one individual address associated with the list identifier, as shown in step 72 in Fig. 5, and disclosed at line 23 on page 11 through line 2 on page 12 of the Specification.

Dependent claims 6, 12 and 18 are directed to the include set of recipient entities including a list identifier, and resolving that list identifier at the destination server system, where the resolving includes determining at least one individual address associated with the list identifier, as also shown in step 72 of Fig. 5, and disclosed at line 23 on page 11 through line 2 on page 12 of the Specification.

VI. Grounds of Rejection to be Reviewed on Appeal

A. Claims 1-20 stand rejected as anticipated under 35 U.S.C. 102(e) over United States Published Patent application 2003/0048298 of Ellendman ("Ellendman").

VII. Argument

A. Ellendman does not disclose all the features of the present independent claims 1, 7, 13, 19 and 20. Ellendman accordingly does not anticipate the present independent claims 1, 7, 13, 19 and 20 under 35 U.S.C. 102. The dependent claims 2-6, 8-12 and 14-18 are patentable over Ellendman for at least the same reasons.

It is well established that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Appellant asserts that the rejection of claims 1-20 under 35 U.S.C. 102 fails to meet this requirement, since Ellendman does not include the presently claimed *assigning the difference between include and exclude sets of recipient entities at a source server system*, in combination with *determining the result of a difference operation between the include and exclude sets of recipient entities at a destination servers system*, and *sending a message to destinations indicated by recipient entities within the result of the difference operation between the include set of recipient entities and the exclude*

set of recipient entities at the destination server system, as in the present independent claims 1, 7, 13, 19 and 20. In contrast, the Ellendman reference includes no mention of operations or functions performed at any server system, whether source or destination.

Ellendman, United States Published Patent application 2003/0048298:

Ellendman discloses a system in which one or more user input fields in a user interface screen are used to specify addresses to be removed from address fields prior to sending an outgoing e-mail message. The user input fields of Ellendman are described as including a field used to specify addresses to be removed from a "To" field, a field used to specify addresses to be removed from a "Cc" field, a field used to specify addresses to be removed from a "Bcc" field, and a field used to specify addresses to be removed from all address fields. See Abstract, Fig. 2 and Fig. 6, and related text in Ellendman.

Claims 1-20:

Nowhere in Ellendman is there disclosed or suggested any system or method for:

assigning, by a source server system, a difference between said include set of recipient entities and said exclude set of recipient entities to said include set of recipient entities;
determining, by a destination server system, a result of a difference operation between said include set of recipient entities and said exclude set of recipient entities; and

sending, by said destination server system, said message to destinations indicated by those recipient entities within said result of said difference operation between said include set of recipient entities and said exclude set of recipient entities. (emphasis added)

as in the present independent claim 1. Independent claims 7, 13 and 20 include analogous features. In contrast to the above highlighted features of the present independent claims, Ellendman includes no mention of operations or functions performed at any server system, whether source or destination. Accordingly, Ellendman fails to provide even a suggestion of the possibility of performing the above highlighted steps of *assigning the difference between include and exclude sets of recipient entities at a source server system*, in combination with *determining the result of a difference operation between the include and exclude sets of recipient entities at a destination servers system*, and *sending a message to destinations indicated by recipient entities within the result of the difference operation between the include set of recipient entities and the exclude set of recipient entities at the destination server system*, as in the present independent claims. As Ellendman includes no discussion of source and/or destination server systems, it similarly lacks any teaching or suggestion regarding transferring an exclusion list to any system other than a client system typically used to generate e-mail application user interface screens. Processing of any exclusion lists based on the teachings in Ellendman can therefore only be understood as being performed within the same system that generated the user interface fields shown in Figs. 2 and 6 of Ellendman, i.e. the end user, client system.

These distinctions of the present independent claims over Ellendman are made clear by the specific teachings of Ellendman, which are directed to operation of a client computer system associated with a local user. The illustrations of user interface screens shown in Figs. 1, 2 and 6 of Ellendman show a new message composition user interface provided by a client computer system to a local user for creating a new outgoing message 11. Paragraphs 13 and 14 of Ellendman specifically indicate that the "fields" of the Ellendman user interface, e.g. the "remove" fields 26, 27, 28, 24 and 64 are *user input fields* in an e-mail application new message composition user interface. Paragraph 13 of Ellendman expressly calls for "using a pointing device to place a cursor over address field 13". These teachings indicate that the presentation of the user input fields is performed by a typical client computer system having a pointing device (e.g. a mouse) controlled by the end user. In addition, the processing of the contents of the user interface input fields of Ellendman is performed prior to the message being sent, as indicated by the text accompanying the steps of the flow charts of Figs. 3, 4 and 5, which states that these steps are performed with regard to "an outgoing e-mail message". Since the processing of the exclusion fields in these flow charts is specifically performed with regard to an "outgoing e-mail message", Ellendman cannot reasonably be considered to teach exclusion list processing at any system other than the end user's client computer system on which the user interface screens of Figs. 1, 2 and 6 are presented, and in which the steps of flow charts 3, 4 and 5 are performed prior to sending the e-mail message. Ellendman therefore does not even foresee a need for having the above

highlighted features of the present independent claims, which are both provided externally to the client computer system, at a *source server system* and a *destination server system*.

The Examiner cites portions of Ellendman referring to e-mail addresses that include domain name portions (e.g. paragraphs 24-28). However, the fact that some of the *destination addresses* used in the Ellendman description include text portions such as "headquarters", "localpaper", "radiostation", etc., only indicates that the Ellendman system is capable of operation using e-mail addresses in the well known Internet format.

As is well known in the art, in electronic mail addresses such as "Jan_Smith@headquarters" and the like, the part of the address after the @ sign (e.g. "headquarters") is typically the domain-part of the address, which may be a host name or domain name of the address, and may be used to perform lookups in the Domain Name System (DNS) to find the mail transfer agent or Mail eXchangers (MXs) accepting e-mail for that address. The domain name of such e-mail addresses often refers to an e-mail service, or can be the domain name of a company that the recipient represents, or the domain of the recipient's personal site.

The use of e-mail addresses including domain names by the Ellendman system provides no teaching or suggestion of the above highlighted features of the present independent claims. The fact that Ellendman is capable of handling e-mail addresses with different domain parts provides no hint or suggestion as to how any part of the processing disclosed in Ellendman might possibly be

performed by any specific server system. Moreover, the specific domain-parts of e-mail addresses used as examples in the Ellendman description have no significance with regard to Ellendman's inputting and/or processing of exclusion lists.

For these reasons, Applicant respectfully urges that all the features of each of the present independent claims 1, 7, 13, 19 and 20 are not disclosed or suggested by Ellendman. The present independent claims are accordingly not anticipated by Ellendman. As to the claims 2-6, 8-12, and 14-18 they each depend from one of independent claims 1, 7, and 13, and are respectfully believed to be patentable over Ellendman for at least the same reasons.

VIII. Conclusion

Appellants submit therefore that the rejections of the present claims under 35 U.S.C. 102 based on Ellendman, are improper for at least the reasons set forth above. Appellants accordingly request that the rejections be withdrawn and the pending claims be allowed.

Respectfully submitted,

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Appendix A - Claims

1. (previously presented) A method for processing a message for transmission, comprising:

determining an include set of recipient entities, wherein said determining said include set of recipient entities includes displaying at least one destination user input field within a graphical user interface window and inputting said include set of recipient entities from said at least one destination user input field;

determining an exclude set of recipient entities, wherein said determining said exclude set of recipient entities includes displaying at least one exclude user input field within said graphical user interface window and inputting said exclude set of recipient entities from said at least one exclude user input field;

assigning, by a source server system, a difference between said include set of recipient entities and said exclude set of recipient entities to said include set of recipient entities;

determining, by a destination server system, a result of a difference operation between said include set of recipient entities and said exclude set of recipient entities; and

sending, by said destination server system, said message to destinations indicated by those recipient entities within said result of said difference operation between said include set of recipient entities and said exclude set of recipient entities.

2. (original) The method of claim 1, wherein said determining said include set of recipient entities further comprises displaying at least one carbon copy user input field

within said graphical user interface window and inputting at least one of said include set of recipient entities from said at least one carbon copy user input field.

3. (original) The method of claim 2, wherein said determining said include set of recipient entities further comprises displaying at least one blind carbon copy user input field within said graphical user interface window and inputting at least one of said include set of recipient entities from said at least one blind carbon copy user input field.

4. (previously presented) The method of claim 1, wherein one of said recipient entities in said include set of recipient entities comprises a list identifier, and further comprising resolving said list identifier in said source server system, wherein said resolving includes determining at least one individual address associated with said list identifier.

5. (previously presented) The method of claim 4, wherein at least one of said recipient entities in said exclude set of recipient entities comprises a second list identifier, and further comprising:

resolving said second list identifier at said destination server system, wherein said resolving includes determining at least one individual address associated with said second list identifier.

6. (previously presented) The method of claim 5, wherein a second one of said recipient entities in said include set of recipient entities comprises a third list identifier, and further comprising:

resolving said third list identifier at said destination server system, wherein said resolving includes determining at least one individual address associated with said third list identifier.

7. (previously presented) A computer program product, wherein said computer program product includes a computer readable medium, said computer readable medium having a computer program for processing a message for transmission stored thereon, said computer program comprising:

program code for determining an include set of recipient entities, wherein said determining said include set of recipient entities includes displaying at least one destination user input field within a graphical user interface window and inputting said include set of recipient entities from said at least one destination user input field;

program code for determining an exclude set of recipient entities, wherein said determining said exclude set of recipient entities includes displaying at least one exclude user input field within said graphical user interface window and inputting said exclude set of recipient entities from said at least one exclude user input field;

program code for assigning, by a source server system, a difference between said include set of recipient entities and said exclude set of recipient entities to said include set of recipient entities;

program code for determining, by a destination server system, a result of a difference operation between said include set of recipient entities and said exclude set of recipient entities; and

program code for sending, by said destination server system, said message to destinations indicated by those recipient entities within said result of said difference operation between said include set of recipient entities and said exclude set of recipient entities.

8. (original) The computer program product of claim 7, wherein said program code for determining said include set of recipient entities further comprises program code for displaying at least one carbon copy user input field within said graphical user interface window and for inputting at least one of said include set of recipient entities from said at least one carbon copy user input field.

9. (original) The computer program product of claim 8, wherein said program code for determining said include set of recipient entities further comprises program code for displaying at least one blind carbon copy user input field within said graphical user interface window and for inputting at least one of said include set of recipient entities from said at least one blind carbon copy user input field.

10. (previously presented) The computer program product of claim 7, wherein one of said recipient entities in said include set of recipient entities comprises a list identifier, and wherein said computer program further comprises program code for resolving said list identifier in said source server system, wherein said resolving includes determining at least one individual address associated with said list identifier.

11. (previously presented) The computer program product of claim 10, wherein at least one of said recipient entities in said exclude set of recipient entities comprises a second list identifier, and said computer program further comprising:

program code for resolving said second list identifier at said destination server system, wherein said resolving includes determining at least one individual address associated with said second list identifier.

12. (previously presented) The computer program product of claim 11, wherein a second one of said recipient entities in said include set of recipient entities comprises a third list identifier, and said computer program further comprising:

program code for resolving said third list identifier at said destination server system, wherein said resolving includes determining at least one individual address associated with said third list identifier.

13. (previously presented) A system for processing a message for transmission, said computer program comprising:

means for determining an include set of recipient entities, wherein said determining said include set of recipient entities includes displaying at least one destination user input field within a graphical user interface window and inputting said include set of recipient entities from said at least one destination user input field;

means for determining an exclude set of recipient entities, wherein said determining said exclude set of recipient entities includes displaying at least one exclude

user input field within said graphical user interface window and inputting said exclude set of recipient entities from said at least one exclude user input field;

means for assigning, by a source server system, a difference between said include set of recipient entities and said exclude set of recipient entities to said include set of recipient entities;

means for determining, by a destination server system, a result of a difference operation between said include set of recipient entities and said exclude set of recipient entities; and

means for sending, by said destination server system, said message to destinations indicated by those recipient entities within said result of said difference operation between said include set of recipient entities and said exclude set of recipient entities.

14. (original) The system of claim 13, wherein said means for determining said include set of recipient entities further comprises means for displaying at least one carbon copy user input field within said graphical user interface window and for inputting at least one of said include set of recipient entities from said at least one carbon copy user input field.

15. (original) The system of claim 14, wherein said means for determining said include set of recipient entities further comprises means for displaying at least one blind carbon copy user input field within said graphical user interface window and for inputting at least one of said include set of recipient entities from said at least one blind carbon copy user input field.

16. (previously presented) The system of claim 13, wherein one of said recipient entities in said include set of recipient entities comprises a list identifier, and further comprising means for resolving said list identifier in said source server system, wherein said resolving includes determining at least one individual address associated with said list identifier.

17. (previously presented) The system of claim 16, wherein at least one of said recipient entities in said exclude set of recipient entities comprises a second list identifier, and further comprising:

means for resolving said second list identifier at said destination server system, wherein said resolving includes determining at least one individual address associated with said second list identifier.

18. (previously presented) The system of claim 17, wherein a second one of said recipient entities in said include set of recipient entities comprises a third list identifier, and further comprising:

means for resolving said third list identifier at said destination server system, wherein said resolving includes determining at least one individual address associated with said third list identifier.

19. (previously presented) A system including a computer readable memory, said computer readable memory having program code stored thereon for processing a message for transmission, said program code comprising:

program code for determining an include set of recipient entities, wherein said determining said include set of recipient entities includes displaying at least one destination user input field within a graphical user interface window and inputting said include set of recipient entities from said at least one destination user input field;

program code for determining an exclude set of recipient entities, wherein said determining said exclude set of recipient entities includes displaying at least one exclude user input field within said graphical user interface window and inputting said exclude set of recipient entities from said at least one exclude user input field;

program code for assigning, by a source server system, a difference between said include set of recipient entities and said exclude set of recipient entities to said include set of recipient entities;

program code for determining, by a destination server system, a result of a difference operation between said include set of recipient entities and said exclude set of recipient entities; and

program code for sending, by said destination server system, said message to destinations indicated by those recipient entities within said result of said difference operation between said include set of recipient entities and said exclude set of recipient entities.

20. (previously presented) A computer data signal embodied in a carrier wave, said computer data signal including at least one computer program for processing a message for transmission, said computer program comprising:

program code for determining an include set of recipient entities, wherein said determining said include set of recipient entities includes displaying at least one destination user input field within a graphical user interface window and inputting said include set of recipient entities from said at least one destination user input field;

program code for determining an exclude set of recipient entities, wherein said determining said exclude set of recipient entities includes displaying at least one exclude user input field within said graphical user interface window and inputting said exclude set of recipient entities from said at least one exclude user input field;

program code for assigning, by a source server system, a difference between said include set of recipient entities and said exclude set of recipient entities to said include set of recipient entities;

program code for determining, by a destination server system, a result of a difference operation between said include set of recipient entities and said exclude set of recipient entities; and

program code for sending, by said destination server system, said message to destinations indicated by those recipient entities within said result of said difference operation between said include set of recipient entities and said exclude set of recipient entities.

Appendix B - Evidence Submitted

None.

Appendix C - Related Proceedings

None.